



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09 646,906	10 10 2000	Mitsunori Nagashima	P100806-0000	5977

7590 01.08.2003

Arent Fox Kintner Plotkin & Kahn  
Nikaido Marmelstein Murray & Oram  
1050 Connecticut Avenue NW Suite 600  
Washington, DC 20036-5339

EXAMINER

VORTMAN, ANATOLY

ART UNIT	PAPER NUMBER
----------	--------------

2835

DATE MAILED: 01/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/646,906

Applicant(s)

NAGASHIMA, MITSUNORI

Examiner

Anatoly Vortman

Art Unit

2835

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 November 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1, 2 and 4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other:

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1, 2, and 4, are rejected under 35 U.S.C. 103(a) as being unpatentable over the Applicant's disclosure in view of GB/2,302,451 to Shirakawa et al., (Shirakawa).

Regarding claim 1, the Applicant admitted ("Prior Art" Fig. 3A and 3B) that it has been known in the art at the time the invention was made to use a mount structure for thermal fuse (34) on circuit board (31), comprising:

a circuit board (31) having a surface where a predetermined circuit (for an electronic component (32)) is formed; said electronic component (32) attached to the one surface of said circuit board (31);

a thermal fuse (34) provided on said one surface of said circuit board (31) in a close proximity to said electronic component (32), responding to the temperature of said electronic component (32) via heat conducting insulating member (33) filling the separation between said electronic component (32) and said thermal fuse (34) for breaking said predetermined circuit; and a through hole in the circuit board (31), wherein said thermal fuse (34) is electrically connected to said predetermined circuit via said through hole (by leads (35)), but did not disclose

an opening in said circuit board, wherein said electronic component (32) and said thermal fuse (34) are arranged across said opening and on opposite surfaces of said circuit board (31).

Shirakawa disclosed (Fig. 2) a mounting arrangement for electronic components (1 and 2) on a circuit board (3), said circuit board (3) having a through opening (9), wherein said electronic component (1) is attached to one surface of the circuit board (3) to extend across said through opening (9), and another electronic component (2) provided on the other surface of said circuit board (3) to enter said through opening (9), wherein an insulating member (4) is filling said opening (9).

Since the mounting arrangement disclosed by "Prior Art" Fig. 3A and 3B of the present invention and the invention of Shirakawa are from the same field of endeavor (mounting arrangements for electronic components on a circuit board), the purpose of mounting the electronic components across the opening and on opposite sides of the circuit board disclosed by Shirakawa would be recognized in the prior art mounting arrangement depicted on Fig. 3A and 3B of the instant application.

It would have been obvious to a person of ordinary skill in the electronic device and fuse arts at the time the invention was made to modify said prior art mounting arrangement depicted on Fig. 3A and 3B of the instant application according to the teachings of Shirakawa by providing said circuit board (31) with a through opening, by placing said electronic component (32) across said opening and by placing said thermal fuse (34) on the other surface of said circuit board (31) to enter said through opening for responding to the temperature of said electronic component (32) through a heat conducting filler (33), in order to reduce the size (i.e. the height) of the assembly (for motivation, please see Shirakawa, p.3, lines 4+; and p.8, lines 12+).

Art Unit: 2835

Also, regarding claim 1, the Examiner believes that a following case law would be applicable: "It is noted that where a part of a device may be relocated without modification to the operation of the device (emphasis added), such a relocation is considered to have been within the skill of the art". *In re Japikse*, 86 USPQ 70 (1950).

Regarding claim 2, the Applicant admitted that said heat conducting insulating member (33) is a silicone resin (instant application, last line of page 1).

Regarding claim 4, the "Prior Art" Fig. 3A and 3B of the instant application depict a rod-shaped thermal fuse (34).

### ***Response to Arguments***

3. By amendment filed on 11/27/02, the Applicant has merely combined previously rejected claims 1 and 3. Thus, no new and allowable subject matter has been introduced into the new amended claim 1.

The main thrust of the Applicant's arguments is directed to the assertion that there is no motivation for combining the references (p. 4, lines 16+ of the amendment).

The Examiner would like to direct the Applicant's attention to the fact that motivation has been presented in the body of the rejection above and in the previous Office Action (p. 3, last line).

Also, the Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. *In re Nomiya*, 184 USPQ 607 (CCPA 1975).

Art Unit: 2835

However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. *In re McLaughlin*, 170 USPQ 209 (CCPA 1971). References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. *In re Bozek*, 163 USPQ 545 (CCPA) 1969.

### *Conclusion*

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anatoly Vortman whose telephone number is 703-308-7824. The examiner can normally be reached on 9:30-6:00, Monday-Friday.

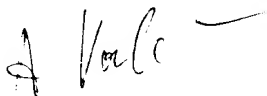
Art Unit: 2835

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Darren Schuberg can be reached on 703-308-4815. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3431 for regular communications and 703-305-3432 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1782.

Anatoly Vortman  
Primary Examiner  
Art Unit 2835

A.V.  
January 6, 2003

A handwritten signature in dark ink, appearing to read 'A Vortman', followed by a horizontal line.